



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/854,306      | 05/11/2001  | Eric Yang            | 15448-0502          | 7816             |

29989 7590 09/28/2005

HICKMAN PALERMO TRUONG & BECKER, LLP  
2055 GATEWAY PLACE  
SUITE 550  
SAN JOSE, CA 95110

EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/854,306

Applicant(s)

YANG ET AL.

Examiner

Janice A. Mooneyham

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-142 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-142 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on May 11, 2001.

Claims 1-142 are currently pending.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on August 6, 2001 is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-71 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Art Unit: 3629

In the present case, claims 1-71 only recite an abstract idea. The recited steps of merely receiving an inquiry, access the information, determining a licensing amount, updating a parameter and allowing an item to be used does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to manage a contract. There is not technology recited in the body of the claims.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "a computer implemented method". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 3629

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-17, 19, 22-49, 51, 55-64, 72-88, 90, 93-120, 122, and 126-135 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al (US 2004/0133793) (hereinafter referred to as Ginter).

Referring to Claims 1 and 72:

Ginter discloses a computer implemented method and medium for managing a contract ([0012] electronic contract), comprising:

receiving an inquiry regarding licensing of a first set of software under a particular contract ([0012] electronic contract, [0053], [0078-0081] Electronic content, [0093], [0161-0162], Figures 72A-72D, [0137];

accessing information pertaining to the contract, the information comprising quota parameters which specifies a quota of resources that can be consumed under the contract ([0161-0162] parameters [0166] metering the number of copies, Figures 3 and 4, [0214],[0426-0433]);

determining a first licensing (subsets or extended agreements) amount attributable to licensing the first set of software ([0012],[0405] how much it costs to use the content, [0410-0411] specify how much it costs,[0426-0431], Figure 26A (944) number of rights record, Figure 50d (1718));

updating the quota parameter based, at least partially, upon the first licensing amount (Figure 61 (2239) update Meter, [0393]) ; and

allowing the first set of software to be used under the contract (Figure 3 (402) GO, [0061-0062] distribution of permissions to use electronic information).

Referring to Claims 23 and 94:

Ginter discloses a computer implemented method and medium for managing a contract ([0012] electronic contract), comprising:

receiving a first inquiry regarding licensing of a first set of software under a particular contract ([0012] electronic contract, [0053], [0078-0081] electronic content, [0093], [0161-0162], Figures 72A-72D, [0137]);

accessing information pertaining to the contract, the information comprising quota parameter which specifies a quota of resources that can be consumed under the contract, and one or more contract terms associated with the contract ([0161-0162], [0166] metering the number of copies, Figures 3 and 4, [0426-0433]);

determining a first licensing amount (subsets or extended agreements) attributable to licensing the first set of software, said licensing amount determined, at least partially, by applying one or more of the contract terms ([0012], [0405] how much it costs to use the content, [0410-0411] specify how much it costs, [0426-0431]; Figure 26A (944) number of rights record; Figure 50d (1718));

updating the quota parameter based, at least partially, upon the first licensing amount (Figure 61 (2239) update Meter, [0393]); and

allowing the first set of software to be used under the contract ([0062] Figure 3 (402) GO).

Referring to Claims 56-64 and 127-135:

Ginter discloses a computer implemented method and medium for managing a contract ([0012] electronic contract), comprising:

receiving a first inquiry regarding licensing of a first set of software under a particular contract ([0012] electronic contract, [0053], [0078-0081] electronic content, [0093],[0161-0162], Figures 72A-72D, [0137];

accessing information pertaining to the contract, the information comprising quota parameter which specifies a quota of resources that can be consumed under the contract, and one or more contract terms associated with the contract ([0161-0162] parameters, [0166] metering the number of copies, Figures 3 and 4, [0214], [0426-0433]);

accessing one or more other sets of information pertaining to one or more other contracts related to the contract ([0012] and [0161-0162]), each of the other sets of information comprising one or more contract terms associated with one of the contracts (Figures 3-4, [0061] [0077-0081];

processing the information in a particular order and searching as each set of information is processed to derive one or more applicable contract terms that apply to the inquiry by reconciling the information to extract one or more applicable contract terms and upon finding a contract term that applies, including the term as one or more applicable contract terms [0163-0165];

determining a first licensing amount attributable to licensing the first set of software, said licensing amount determined, at least partially, by applying one or more

Art Unit: 3629

of the contract terms ([0012], [0405] how much it costs to use the content, [0410-0411 specify how much it costs, [0426-0431]; Figure 26A (944) number of rights record; Figure 50d (1718);

updating the quota parameter based, at least partially, upon the first licensing amount (Figure 61 (2239) update Meter, [0393]); and

allowing the first set of software to be used under the contract ([0062] Figure 3 (402) GO).

Referring to Claims 2, 5-10, 24, 29-37, 73, 76-81, 95, and 100-108:

Ginter discloses a method and medium further comprising:

receiving a second inquiry regarding licensing a second set of software, or obtaining a service comprising technical support, or purchasing a product under the contract or a set of property comprising intellectual property or proprietary information ([0025],[0046-0052], [0071], [0093], [0161-0162], [0174]);

determining a second licensing amount, service amount, purchasing amount attributable to licensing the second set of software, obtaining the services, purchasing the product, or licensing the property, by applying one or more contract terms ([0012], [0405] how much it costs to use the content, [0410-0411 specify how much it costs, [0426-0431]; Figure 26A (944) number of rights record; Figure 50d (1718);

updating the quota parameter based, at least partially, upon the second licensing amount, service amount, purchasing amount ((Figure 61 (2239) update Meter, [0393]); and



Art Unit: 3629

allowing the second set of software to be used under the contract, the service to be rendered, the product to be purchased, or the property used ([0062] Figure 3 (402) GO).

Referring to Claims 3, 25, 74, and 96:

Ginter discloses wherein the first set of software and the second set of software are different sets of software ([0012], [0061][0107] [0161].

Referring to Claim 4, 26, 75, and 97:

The fact that the second set of software is an upgraded version of the first set of software is determined to be non-functional descriptive data since the method would be performed the same no matter whether the software was an upgrade or not. The type of software is not functionally interrelated with the steps of the invention and thus will not serve as a limitation. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994).

Referring to Claims 11, 41, 82, and 112:

Ginter discloses wherein updating the quota parameter comprises reducing the parameter by the first licensing amount ((Figure 61 (2239) update Meter, [0393], [0161])).

Referring to Claims 27-28 and 98-99:

Ginter discloses wherein the one or more contract terms applied to determine the first licensing amount are the same as/different from the one or more contract terms applied to determine the second licensing amount ([0161-0162]).

Art Unit: 3629

Referring to Claims 12-16, 42-46, 48, 83-87, 113-117, and 119:

Ginter discloses wherein the first inquiry specifies one or more additional inquiry parameters and wherein the amount is determined based, at least partially, upon at least one of the additional inquiry parameters, wherein the parameter is specified by the sender of the inquiry and wherein the one or more parameters comprises indicating a desired amount of time or duration of the license, how many users may concurrently use the software, how many copies of the software are desired (Figures 72A-72D).

Referring to Claims 17, 49, 88, and 120:

Ginter discloses granting a license to use the item for a period of time ([0189], [0190], 0196-0197], [216]).

Referring to Claims 19, 51, 90, and 122:

Ginter discloses disallowing use of the item under the contract (Figure 3 (402) NO GO).

Referring to Claims 22, 55, 93 and 126:

Ginter discloses receiving a request to deploy the software and deploying the software to a host specified by a sender ([0032-0035], [0061-0062]).

Referring to Claims 38-40, and 109-111:

Ginter discloses wherein the one or more contract terms comprise an uplift, a discount or a multiplier ([0174], [0186-0190]).

Art Unit: 3629

Referring to Claims 47 and 118:

Ginter discloses wherein the first inquiry specifies a set of inquiry parameters, which include a reference to the first set of software and one or more additional inquiry parameters, and wherein determining the licensing amount comprises determining, based at least partially upon one or more of the inquiry parameters which of said one or more contract terms to apply to the first inquiry [0161-0162].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 18, 20-21, 50, 52-54, 65-71, 89, 91-92, 121, 123-125 and 136-142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter.

Referring to Claims 18, 20-21, 50, 52-54, 65-71, 89, 91-92, 121, 123-125 and 136-142:

Ginter discloses a computer-implemented method for managing a contract ([0012] electronic contract), comprising:

accessing information pertaining to the license, the information comprising a reference to a contract with one or more contract terms under which the license was granted, the contract having quota parameters associated therewith which specify a quota of resources that can be consumed under the contract; the information to the

Art Unit: 3629

license further comprising a licensing amount attributable to the licensing of the software [0161-0163];

Ginter discloses usage auditing, reporting, and payment [0078].

Ginter does not discloses receiving a request to terminate a license, determining a refund amount and updating the quota parameter based upon the refund.

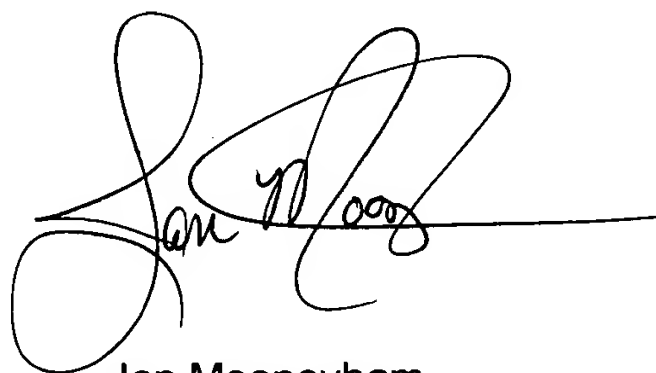
However, it would have been obvious to one of ordinary skill in the art to incorporate into the disclosure of Ginter a refund mechanism since it makes good business sense to provide a credit for unused portions so as to maintain customer satisfaction and loyalty.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", written over a horizontal line.

Jan Mooneyham  
Patent Examiner  
Art Unit 3629